



1638

Dkt. 2992/73607/JPW/GJG/JRM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Josette Masle et al.
Serial No. : 10/519,135 Examiner : Kumar, Vinod
Filed : August 15, 2005 Art Unit : 1638
For : METHOD OF PRODUCING PLANTS HAVING ENHANCED
TRANSPIRATION EFFICIENCY AND PLANTS PRODUCED
THEREFROM

1185 Avenue of the Americas
New York, New York 10036
May 1, 2008

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**COMMUNICATION IN RESPONSE TO APRIL 22, 2008 NOTICE OF
NON-COMPLIANT AMENDMENT (37 CFR 1.121), CONFIRMATION
OF MAY 1, 2008 TELEPHONE CONFERENCE AND
REQUEST FOR EXPEDITED PROSECUTION**

This Communication is submitted in response to the April 22, 2008 Notice of Non-Compliant Amendment (37 CFR 1.121) issued by the United States Patent and Trademark Office in connection with the above-identified application. A copy of the April 22, 2008 Notice is attached hereto as Exhibit A. A response to the April 22, 2008 Notice is due May 22, 2008. Accordingly, this Communication is being timely filed.

The April 22, 2008 Notice alleged that the January 30, 2008 and February 29, 2008 Amendments submitted in connection with the subject application were improper. After reviewing the January 30, 2008 and February 29, 2008 Amendments, applicants respectfully maintain that the amendments are not improper and that the February 22, 2008 Notice was received in error.

Applicants : Josette Masle et al.
Serial No. : 10/519,135
Filed : August 15, 2005
Page 2 of 3 of May 1, 2008 Communication

This Communication also confirms the May 1, 2008 telephone conference between Examiner Phuong T. Bui of the United States Patent and Trademark Office and James R. Major, D.Phil. of the undersigned's office. During the May 1, 2008 telephone conference Examiner Phuong advised Dr. Major that the United States Patent and Trademark Office should have issued a Communication addressing the non-consecutive numbering of the claims in the May 14, 2007 Amendment, but failed to do so. Applicants corrected the numbering of the claims in the January 30, 2008 Amendment. Examiner Phuong advised Dr. Major that the claims listed in the February 29, 2008 Amendment should be resubmitted.

In response to Examiner Phuong's request, applicants attach hereto as Exhibit B a corrected listing of all the pending claims.

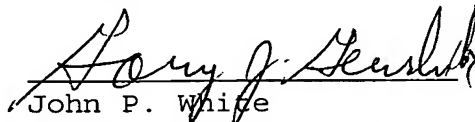
In view of the delay in prosecution caused by the incorrectly issued Notice, applicants respectfully request that the Examiner expedite prosecution of the subject application.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

Applicants : Josette Masle et al.
Serial No. : 10/519,135
Filed : August 15, 2005
Page 3 of 3 of May 1, 2008 Communication

No fee is deemed necessary in connection with the filing of this Communication. However, if any additional fee is required authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,


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Registration No. 28,678
Gary J. Gershik
Registration No. 39,992
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New York, New York 10036
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<p>I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:</p> <p>Mail Stop Amendment Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450</p> <p> 5/1/08 Gary J. Gershik Date Reg. No. 39,992</p>

Exhibit A

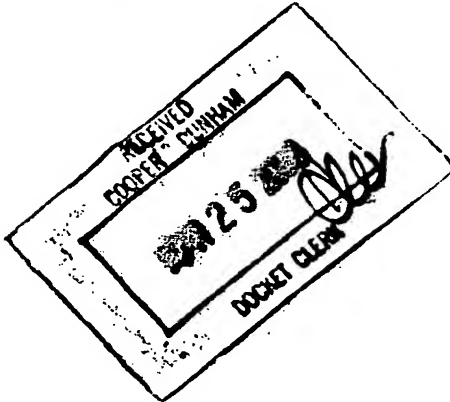
3992/73607

SPW/657/JRN

Notice of Non-Compliant Amendment (37 CFR 1.121)	Application No.	Applicant(s)	
	10/519,135	MASLE ET AL.	
	Examiner	Art Unit	
	VINOD KUMAR	1638	

Notice of non-compliant amendment Due 5
Report CH → 5/6/08

2mu-6/22/08
3mu-7/22/08
4mu-8/22/08
5mu-9/22/08
6mu-10/22/08



Applicants : Josette Masle et al.
U.S. Serial No. : 10/519,135
Filed : August 15, 2005

Exhibit A

Continuation Sheet (PTOL-324)

Application No. _____

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 03 March 2008 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims).
 - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☒ E. Other: It is noted that Applicant's claim amendment filed in the paper of March 3, 2008 fails to comply with 37 CFR 1.121. Since a request for continued examination (RCE) is not a new application, an amendment filed before the first Office action after the filing of RCE is not a preliminary amendment. See MPEP § 706.07(h). Also, claim amendment filed in the paper of March 3, 2008 shows claim 48 as new claim. However claim 48 was examined on merits in the Office action mailed on 7/31/2007. Status of claims filed with RCE must correspond with the claims introduced after final must be identified under "New". It is also noted that Applicant's claim amendment filed in the paper of 3/3/08 presents additional claims without cancelling a corresponding number of finally rejected claims. See 37 CFR 1.118 and 41.33(a). In view of this, the amendments filed in the papers of 02/04/08 and 03/03/08 are not entered.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4): _____

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment must be resubmitted**.
2. Applicant is given **one month, or thirty (30) days, whichever is longer**, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action. If any of above boxes 1. to 4. are checked, the correction required is only the corrected section of the non-compliant amendment in compliance with 37 CFR 1.121.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

- Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or
- Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

/Phuong T Bui/ 4/18/07

Legal Instruments Examiner (LIE), if applicable

Telephone No. _____

Continuation Sheet (PTOL-324)
U.S. Patent and Trademark Office
PTOL-324 (01-08)

Notice of Non-Compliant Amendment (37 CFR 1.121)

Application No.
Part of Paper No. 20080322



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,135	08/15/2005	Josette Masle	2251/73607/JPW/MJW	3638
33432	7590	04/22/2008	EXAMINER	
COOPER & DUNHAM, LLP 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			ART UNIT	PAPER NUMBER

DATE MAILED: 04/22/2008

Please find below and/or attached an Office communication concerning this application or proceeding.

Exhibit B

Exhibit B

- 1-36. (Canceled)
37. (Currently Amended) A method of obtaining a plants having enhanced transpiration efficiency which comprises transforming a culture of plant cells with a nucleic acid encoding an ERECTA protein having an amino acid sequence set forth in SEQ ID NO: 2 under conditions such that the nucleic acid is transcribed to form a transcription product which is then expressed in the plant cells, generating plants from the culture of plant cells, and selecting for a plants having i) enhanced transpiration efficiency compared to plants generated from the plant cells present in the same culture which were not transformed with the nucleic acid, and ii) the transcription product of the nucleic acid in its leaves.
38. (Currently Amended) The method of claim 37, wherein the method further comprises propagating the selected plant ~~having the enhanced transpirational efficiency.~~
39. (Previously Presented) The method of claim 37, wherein the plant cells of the culture are selected from the group consisting of rice, sorghum, wheat and maize.
40. (Previously Presented) The method of claim 37, wherein the culture of plant cells is transformed with the nucleic acid by transforming the plant cells with a construct comprising a gene which expresses the ERECTA protein.
41. (Previously Presented) The method of claim 37, wherein

Applicants : Josette Masle et al.
U.S. Serial No. : 10/519,135
Filed : August 15, 2005

the plant cells do not comprise a nucleic acid encoding SEQ ID NO: 2 prior to the transformation.

42. (Currently Amended) A method of obtaining a plant having enhanced transpiration efficiency comprising transforming ~~the~~ a plant with a nucleic acid encoding an ERECTA protein having an amino acid sequence set forth in SEQ ID NO: 2 under conditions such that the nucleic acid is transcribed to form a transcription product which is then expressed in the plant, and selecting for a plants having i) enhanced transpiration efficiency compared to the plant prior to transformation with the nucleic acid, and ii) the transcription product of the nucleic acid in its leaves.
43. (Currently Amended) The method of claim 42, wherein the method further comprises propagating the selected ~~plant having the enhanced transpirational efficiency~~.
44. (Previously Presented) The method of claim 42, wherein the plant is selected from the group consisting of rice, sorghum, wheat and maize.
45. (Previously Presented) The method of claim 42, wherein the plant is transformed with the nucleic acid encoding the ERECTA protein by introgression.
46. (Previously Presented) The method of claim 42, wherein the plant is transformed with the nucleic acid by transforming the plant with a construct comprising a gene which expresses the ERECTA protein.
47. (Previously Presented) The method of claim 42, wherein

the plant does not comprise a nucleic acid encoding SEQ ID NO: 2 prior to transformation with the nucleic acid.

48. (Currently Amended) A method of obtaining a plant having enhanced transpiration efficiency which comprises transforming a culture of plant cells with an ERECTA gene under conditions such that the gene is transcribed to form a transcription product which is then expressed in the plant cells, generating plants from the culture of plant cells, and selecting for a plants having i) enhanced transpiration efficiency compared to plants generated from plant cells presented in the same culture which were not transformed with the gene, and ii) the transcription product of the nucleic acid in its leaves.
49. (New) The method of claim 37, further comprising obtaining seeds from the selected plant.
50. (New) The method of claim 42, further comprising obtaining seeds from the selected plant.